

### **REMARKS**

Entry of this Amendment is proper under 37 C.F.R. § 1.116, because the Amendment places the application in condition for allowance for the reasons discussed herein; does not raise any new issue requiring further search and/or consideration, because the amendments amplify issues previously discussed throughout prosecution; and places the application in better form for an appeal should an appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of the Amendment, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are thus respectfully requested.

#### **I. Summary**

As noted in the Office Action Summary, claims 1, 2, and 5-25 stand pending. Claims 3-4 stand cancelled. Claims 1, 8, 11-13 stand allowed. Claims 2, 5-7, 9, 10, 14, 15, 21, 22 and 25 stand rejected. Claims 16-20 and 23-24 stand withdrawn as drawn to non-elected subject matter. The prior allowance of claim 9 was withdrawn in this Office Action.

With entry of the above amendments, Applicants have cancelled withdrawn claims 16-20 and 22-24. Applicants have also cancelled claims 2, 5-7, 10, 22 and 25. Applicants have amended claims 9, 14, 15, and 21. Support for the amendments to the claims can be found at least in the original claims, examples in the specification, and on page 25.

Applicants have introduced new claim 26. Claim 26 is derived from claim 21 as it existed prior to entry of the instant amendment; claim 26 is directed to cosmetic compositions. Therefore, new claim 26 does not introduce subject matter that has not been previously examined. Accordingly, claim 26 should also be entered, because it would not introduce a search burden on the Office.

Applicants have cancelled and amended claims without prejudice to or disclaimer of the cancelled subject matter. Applicants retain the right to file a continuation and/or divisional application on the subject matter cancelled by way of the amendment. Applicants do not believe any prohibited new matter is introduced by entry of the above amendments and entry is respectfully requested.

## **II. Information Disclosure Statement**

Applicants acknowledge receipt of the initialed copy of the 1449 form submitted with the Information Disclosure Statement filed June 28, 2004. Applicants submit herewith a PTO-1449 form listing the Japanese Patent JP-07 252160A, which had been reported with the Office Action dated July 31, 2006, on a PTO-892 form. Applicants provide herewith a translation of the Japanese patent and have indicated that on the PTO-1449 form. As the reference is of record, Applicants assert that no fee or additional Information Disclosure Statement is required. Applicants merely seek that the Japanese patent be cited as a full translation in any patent that should issue from this application.

## **III. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 5-7, 9, 10, 14-15, and 25 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite.

### **Claim 5-7 and 25**

Claim 5 is alleged to be indefinite for not reciting any methodological steps for making a compound, only an extract. Claims 6-7 and 25 depend from claim 5 and therefore also are rejected. Without acquiescing as to the merit of the rejection and in order to advance prosecution, Applicants have canceled claims 5-7 and 25, thereby mooted the rejection.

### **Claim 9**

Claim 9 stands rejected as indefinite. The Office asserts that allegedly the R groups cannot be acetyl groups as R is limited to C<sub>1-5</sub> alkyl groups. Applicants have amended claim 9 as courteously suggested by the Examiner. Accordingly, Applicants request withdrawal of the rejection and allowance of the claim.

### **Claims 10, 14 and 15**

Claims 10 stands rejected as a method of producing 2-O-(β-D-glucopyranosyl) ascorbic acid using a tetra-acyl derivative as an intermediate, but allegedly fails to set forth any methodological step. Claims 14 and 15 are rejected because they depend from claim 10.

Applicants have cancelled claim 10. Applicants have amended claim 14 into independent format. Support for the amendment to claim 14 can be found in at least the

original claims. Applicants respectfully request withdrawal of the rejection and allowance of claim 14.

Claim 15 has been rewritten into independent claim format, and therefore the rejection is mooted. Applicants likewise request the withdrawal of the rejection of claim 15 and its allowance.

#### **IV. Rejections Under 35 U.S.C. § 102**

The prior rejection of claims 2-4, 14, and 18-22 under 35 U.S.C. § 102(b) as anticipated by Yagi et al. (EP Appln. 0 919 218) stand withdrawn. Office Action, page 2.

The prior rejection of claims 16-17 under 35 U.S.C. § 102(a) by Chen (U.S. Patent No. 6,238,672) also stands withdrawn. Office Action, page 2.

Claims 2, 14, and 21-22 stand newly rejected under 35 U.S.C. § 102(b) in view of Japanese Patent application 07252160 [“the ‘160 patent”].

Without acquiescing as to the merits of the allegations made in view of Japanese Patent application 07252160 and in an effort to further prosecution, Applicants have canceled claim 2 and amended claims 14 and 21 as suggested by the Examiner on page 6 of the Office Action. With the amendments to these claims, and thereby to dependent claim 22, the rejection should be mooted. To the extent that the rejection applies to new claim 26, Applicants note that claim 26 is directed to cosmetic compositions, which is not taught nor suggested by the ‘160 patent. Applicants provide herewith a machine translation of the ‘160 patent. As the Office will note, the ‘160 patent refers to alcohol immersion processing and not to an alcohol extract. *See, e.g.*, ¶¶ [0006] and [0009] of translated ‘160 patent. Therefore, the English language abstract summarizing the ‘160 patent does so incorrectly and therefore cannot be relied upon given the teachings of the ‘160 patent as a whole. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

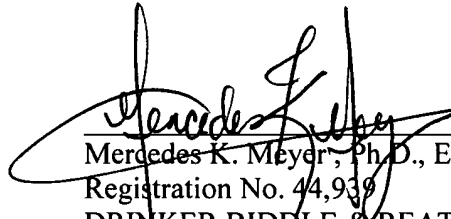
**CONCLUSION**

In view of the above arguments and amendments to the claims, Applicants respectfully assert that the claims are condition for allowance and respectfully request a Notice of Allowance.

Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to charge or credit Deposit Account No. 50-0573 accordingly.

Respectfully submitted,

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